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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,139	02/02/2004	John P. Downs	5398-CIP-CON-3	9662
22922	7590	05/23/2005	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA GABRIEL, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,139

Applicant(s)

DOWNS, JOHN P.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Rejections Withdrawn

1. Claims 1-4, 6-11 and 14-22 rejected under 35 USC 102(b) as being anticipated by Torrey in view of the amendment filed on February 10, 2005.
2. Claims 1-2, 4-10, 12 and 14-19 rejected under 35 USC 102(b) as being anticipated by Aurichio in view of the amendment.
3. Claims 1-22 rejected under 35 USC 103(a) as being unpatentable over Torrey in view of the amendment.
4. Claims 1-22 rejected under 35 USC 103(a) as being unpatentable over Aurichio in view of Torrey in view of the amendment.
5. claims 12 and 13 rejected under 35 USC 112, second paragraph in view of the amendment.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 3-7, 9-16 and 18-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-4, 6-7, 9-11, 14-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Torrey (3741786).

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12), a row of adhesive segments (14) spaced apart along the longitudinal length of the tape, each segments being disposed between the two side edges, and can be transferred by flexing the tape. The adhesive is pressure sensitive adhesive(PSA) (col. 3, line 30). The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line and a single row as shown in figure-4. The segments can be of any shape such as dots, bars, star, triangle, etc. without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. Figures 3-4 shows that the adhesive segments are in a single row. Further, it is understood by the examiner that the phrase "hot melt" would include PSA, such as hot melt PSA.

Art Unit: 1772

The intended use phrases such as "whereby", "may be transversely flexed", "exposable", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-, 3-7, 9-16 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey.

Torrey, as discussed above, fails to teach expressly that the segments are disc shaped. However, Torrey clearly discusses that the shape of the adhesive segments are not critical and it can have any desired shape. Thus, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing its adhesive segments in a disc shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

As for the plurality of adjoining segments of the tape, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing a plurality of adjoining

Art Unit: 1772

segments by cutting a wider carrier tape into longitudinal segments for manufacturing economics, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

11. Applicant's arguments filed February 10, 2005 have been fully considered but they are not persuasive.

Applicant argues that Torrey discloses a PSA segment, that more than one adhesive segment positioned transversely (see figures 1 and 2), and that the "substantially non-contiguous" is defined to encompass adhesive segments that abut, touch, or are attached to each other. These are not deemed to be convincing because Torrey shows, in figures 3 and 4, that the adhesive are non-contiguous, in that PSA segments are spaced apart from each other. Figure 4 also shows the presence of single row of adhesive segment with one adhesive positioned transversely. Thus, claims 1, 7 and 16 are clearly anticipated by Torrey. As for the adhesive, Torrey teaches that adhesive to be PSA and it is examiner's position that said PSA would include hot melt PSA and hence, the hot melt adhesive is taught by said reference. Further, if sufficient heat is provided to the PSA, it would exhibit hot melt characteristics as it would melt under the heat.

Art Unit: 1772

Regarding the new phrase in the claims that "only one of adhesive segments is exposable", said phrase is directed to an intended use of the tape because it is "exposable ...when the adhesive tape is flexed". This intended use phrase is not found to be of positive limitation and hence, has not been given any patentable weight.

As for the segments containing the same number of adhesive segment disposed therein (claim 16), Torrey's figure-4 shows that the adhesive segments are spaced apart and the segment can be defined to include a plurality of said adhesive segments in each of the tape segments.

Regarding the argument that Torrey does not teach that "single adhesive segment is individually exposed when the tape is transversely flexed, applicant is informed that said phrase is directed to an intended use of the tape and is discussed hereinbefore.

As for the shape of the segments being circular or disk shaped, it is found to be an obvious change of shape of the shape of Torrey's segment.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

Terminal Disclaimer

12. The terminal disclaimer filed on February 10, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patents 5,935,670 and 6,686,016 have been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

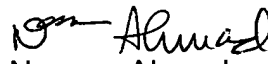
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
September 15, 2004.